

REMARKS

Upon entry of the instant amendment, claims 8-9 will remain pending in the above-identified application and stand ready for further action on the merits.

In this Amendment, claims 8 and 9 have been amended to recite limitations previously recited in claim 1 (and claim 1-6 have been canceled to prevent a redundancy with amended claims). Accordingly, the present amendments to the claims do not introduce new matter into the application as originally filed, or present substantial new issues for the USPTO's consideration after final rejection.

As such entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kuroda JP '579** (JP 11-349579) in view of **Schulz US '956** (US 6,090,956).

Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kuroda JP '579** in view of **Schulz US '956** as applied to claims 1-6, and further in view of **Venturello US '276** (US 4,562,276).

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kuroda JP '579** in view of **Schulz US '956** in view of **Hancock US '032** (US 5,367,032).

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kuroda JP '579** in view of **Schulz US '956** as applied to claims 1-6, and further in view of **Venturello EP '976** (EP 0 606 976).

Reconsideration and withdraw of each of the above rejections is respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

M.P.E.P. § 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP § 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) *combining prior art elements according to known methods to yield predictable results;*
- (b) *simple substitution of one known element for another to obtain predictable results;*
- (c) *use of known technique to improve similar devices (methods, or products) in the same way;*

- (d) *applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;*
- (e) *"obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success*
- (f) *known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;*
- (g) *some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.*

As the M.P.E.P. directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* M.P.E.P. § 2143.03.

Distinctions over the Cited Art

Amended Claim 8

The process claimed in the present claim 8 is a process for producing a β -hydroxyhydroperoxide compound or a carbonyl compound from an olefin.

Kuroda JP '579 and **Schultz US '956** teach a process for producing an epoxy compound from an olefin.

Hancock US '032 discloses a process for producing an epoxy compound from an epoxy compound.

The starting material disclosed in **Kuroda JP '579** and **Schultz US '956** is an olefin and that disclosed in **Hancock US '032** is an epoxy compound, which is different from that disclosed

in **Kuroda JP '579** and **Schultz US '956**. That is, the process disclosed in **Kuroda JP '579** and **Schultz US '956** is quite different from that disclosed in **Hancock US '032**.

Further, **Kuroda JP '579** and **Schultz US '956** do not disclose a process for producing a β -hydroxyhydroperoxide compound or a carbonyl compound.

Therefore, one of ordinary skill in the art would not be motivated to combine the catalyst of **Kuroda JP '579** with the process of **Hancock US '032**, and thus it follows that the presently claimed invention of claim 8 is not obvious over the cited art of record.

Amended Claim 9

The process claimed in the present claim 9 is a process for producing a carbonyl compound from a primary or secondary alcohol.

Kuroda JP '579 and **Schultz US '956** teach a process for producing an epoxy compound from an olefin. The starting material of **Kuroda JP '579** and **Schultz US '956** is quite different from the starting material of the present invention as claimed in claim 9.

Venturello EP '976 also discloses a process for producing a carbonyl-containing compound from an alcohol. However, the starting material of **Venturello EP '976** is quite different from the starting material of **Kuroda JP '579** and **Schultz US '956**. As such, the process disclosed in **Kuroda JP '579** and **Schultz US '956** is quite different from that disclosed in **Venturello EP '976**.

Further, **Kuroda JP '579** and **Schultz US '956** do not disclose a process for producing a carbonyl compound from a primary or secondary alcohol.

Therefore, one of ordinary skill in the art would not be motivated to combine the catalyst of **Kuroda** with the process of **Venturello EP '976**, and thus it follows that the presently claimed invention of claim 9 is not obvious over the cited art of record.

Accordingly, based on the above considerations, it is submitted that the cited art being applied by the USPTO fails to provide any reason or rationale to those of ordinary skill in the art that would allow them to arrive at the instant invention as claimed. Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 8-9 is allowable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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